



UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Gary D. HODGEN

Serial No. : 08/462,703

Group Art Unit: 1618

Filed : June 5, 1995

Examiner: Michael G. HARTLEY

For : ANTIPROGESTIN METHOD AND KIT FOR REDUCING SIDE EFFECTS  
ASSOCIATED WITH LOW DOSAGE HRT, ORAL CNTRACEPTION AND REGULATING  
MENSES

**PETITION TO THE COMMISSIONER**

Mail Stop  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:


This petition is being filed under 37 CFR §1.181 or any other section of the rules which the director might find appropriate.

It is believed that no fee is due for this petition. However, should a fee be due, authorization is hereby granted to charge said fee to Deposit Account No. 13-3402.

**Relevant Facts**

Below is a chronology of relevant papers in this application.

Date	Short Description
March 2, 1992	Grandparent application filed (07/843,048)
September 1, 1993	CIP filed (08/115,008)
June 5, 1995	This application filed
September 12, 1995	All claims (1-41) fully examined
May 8, 1996	Claims 42-81 added
July 19, 1996	Claims 82-107 added
March 17, 1997	All claims (42-107) examined
April 17, 1998	First Rule 129 Submission filed
June 9, 1998	All claims (42-107) examined



March 4, 1999	All claims (42-107) examined
December 6, 1999	All claims (42-107) examined
January 8, 2001	Second 129 Submission
May 22, 2001	New examiner examines all claims (42-107)
November 21, 2001	Interference informally requested
March 5, 2002	<b>Restriction Requirement made and species election required</b>
June 5, 2002	Formal request for interference under 37 CFR §1.607
October 3, 2002	Five additional species aspects to be elected
April 28, 2003	<b>All claims withdrawn except 49, 50 and 55</b>
October 27, 2004	Claims 49, 50 and 55 rejected (all others remain withdrawn)
December 6, 2005	Requirement by PTO that applicants suggest interference under 37 CFR 41.202(a)

#### Relevant Rule

The foregoing facts establish that the PTO has failed to follow its own rules, namely, 37 CFR §1.129(b)(1)-(3). A copy is attached for convenience.

#### Action Requested

**It is hereby requested that the PTO follow the cited rule and provide applicants the notice and time period specified in 37 CFR §1.129(b)(2).**

#### Reasons why the request is justified

When US patent law was dramatically changed, effective June 8, 1995, Congress provided applicants of then pending applications an opportunity to obtain 17 year patents on multiple, patentably distinct inventions being claimed in one application if certain specific conditions were applicable. These conditions are specified in Rule 129(b). As can be seen below, all of these conditions are met by this particular application. Thus, the rule is clearly applicable.

#### (b)(1)

This application has been pending since March 2, 1992, taking into account references made in the application to its earlier filed ancestors. Thus, as of June 8, 1995, it had been pending for at least three years.

Consequently, under (b)(1), the restriction requirement made by the examiner on March 5, 2002, could only have been made if any of the following three conditions existed. Since none apply, this restriction requirement is clearly impermissible.

(i) The restriction requirement of March 5, 2002 was first made on said date and not made in this application or any of the earlier filed ancestor applications prior to April

8, 1995;



(ii) No action of applicant caused the examiner not to have made the restriction requirement earlier than March 5, 2002. Note that claims 42-107 have been pending since July 19, 1996, at least.

(iii) This is not a case where applicants failed to pay a "required fee" for examination. This is clearly inapplicable because the required fees have never been specified by the PTO because Rule 129(b) has not been followed.

(b)(2)

Since the restriction requirement of March 5, 2002 indicates that there is more than one independent and distinct invention and said requirement (pursuant to sections (b)(1) and (2) of 129) properly "cannot be made or maintained," this section of the rule requires that "applicant will be so notified and given a time period to" perform one of three tasks. Applicants have received no such notification and thus, at least for this reason alone, it can be seen that the rule has not been met.

Consequently, applicants have not been given their choice to perform any of the three tasks ((i) elect an invention and pay an extra fee to have more than one invention searched; (ii) confirm a prior election and pay the fee for having more than one invention searched; or (iii) file a petition to have the restriction requirement withdrawn or modified and delay the payment of the fees.

Harm to Applicant

As can be seen from the chronology above, applicants have been trying to have the PTO initiate an interference for several years. These efforts have included a formal request for interference under the then pending rules, filed on June 5, 2002. The patent office has resisted declaration of such an interference. Now the PTO is ignoring applicant's past full compliance with the rules and is insisting on a redundant, second fulfillment of new rules for declaration of an interference. (Whereas it is believed that this is an unfair state of affairs, this has nothing to do with justifying the current petition.)

Rather, the problem here is that applicants have not been given the opportunity mandated by the discussed rule to have more than one independent and distinct invention examined in this application simultaneously. Had this occurred, applicants would now be in the position to forego the filing of an interference request and yet continue with examination of non-interfering subject matter or, perhaps, take an allowance of such subject matter, had the rule been properly followed. This puts applicants in a very untenable situation should it be decided not have an interference declared on the active claims.

In order for applicants to make a decision in its best interests as to whether another formal request for an interference needs to be filed, applicants must have the security of knowing that non-interfering separate inventions will be examined in this application without the need to refile the application thereby depriving claims drawn to such other invention the benefit of a seventeen year patent term. Only at that time, it will be appropriate for applicants to respond to the office action of December 6, 2005.

The Two-Month Period of Rule 181(f)

The captioned rule subsection states that "a petition may be dismissed as untimely" if not filed within two months of the mailing date of the action or notice from which relief is requested.

To the extent the PTO agrees that this petition is seeking relief from the office action of December 6, 2005, the two month period clearly is not at issue.

To the extent the PTO believes that this petition seeks redress of the office action of March 5, 2002, then it is respectfully submitted that the PTO should exercise its discretion ("may be dismissed") and not dismiss this petition for the following reasons.

The undersigned has been practicing before the PTO for about thirty years. In the more than ten years since enactment of Rule 129, the undersigned has been unaware until this instance of any application to which Rule 129(b) applies. The conditions of the rule are such that, it is believed, applicability of this section of the rule is rare indeed. Whereas the undersigned may have been reasonably aware of the nature of its requirements in 1995, because of the rarity of its application in general and the fact that it is never applied to any application the undersigned has been handling to his knowledge, issuance of the restriction requirement of March 5, 2002, failed to alert the undersigned that Rule 129(b) was being violated by the PTO. It appears that the PTO's own staff are also not fully conversant with the cited rule, no doubt in view of its rarity of application and, for example, the fact that the rule was not applied in this case. Whereas ignorance of the law or the rule may be no excuse for not complying with a rule, where both the agency and a long-term practitioner inadvertently fail to recognize the applicability of a little used, obscure rule, it is respectfully submitted to be an understandable oversight on the part of all involved. Especially since failure to apply the rule under the current circumstances would wreak an injustice on applicant as discussed above, it is respectfully submitted that the two-month time period be waived if applicable.

Respectfully submitted,



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Attorney Docket No.: SCH-1309-C03  
Date: December 28, 2005

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the fee set forth in § 1.17(r) are filed prior to the filing of an appeal brief and prior to abandonment of the application. The finality of the final rejection is automatically withdrawn upon the timely filing of the submission and payment of the fee set forth in § 1.17(r). If a subsequent final rejection is made in the application, applicant is entitled to have a second submission entered and considered on the merits after the subsequent final rejection under the following circumstances: The Office will consider such a submission, if the second submission and a second fee set forth in § 1.17(r) are filed prior to the filing of an appeal brief and prior to abandonment of the application. The finality of the subsequent final rejection is automatically withdrawn upon the timely filing of the submission and payment of the second fee set forth in § 1.17(r). Any submission filed after a final rejection made in an application subsequent to the fee set forth in § 1.17(r) having been twice paid will be treated as set forth in § 1.116. A submission as used in this paragraph includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims or drawings and a new substantive argument or new evidence in support of patentability.

(b)(1) In an application, other than for reissue or a design patent, that has been pending for at least three years as of June 8, 1995, taking into account any reference made in the application to any earlier filed application under 35 U.S.C. 120, 121 and 365(c), no requirement for restriction or for the filing of divisional applications shall be made or maintained in the application after June 8, 1995, except where:

(i) The requirement was first made in the application or any earlier filed application under 35 U.S.C. 120, 121 and 365(c) prior to April 8, 1995;

(ii) The examiner has not made a requirement for restriction in the present or parent application prior to April 8, 1995, due to actions by the applicant; or

(iii) The required fee for examination of each additional invention was not paid.

(2) If the application contains more than one independent and distinct invention and a requirement for restriction or for the filing of divisional applications cannot be made or maintained pursuant to this paragraph, applicant will be so notified and given a time period to:

(i) Elect the invention or inventions to be searched and examined, if no election has been made prior to the notice, and pay the fee set forth in 1.17(s) for each independent and distinct invention claimed in the application in excess of one which applicant elects;

(ii) Confirm an election made prior to the notice and pay the fee set forth in § 1.17(s) for each independent and distinct invention claimed in the application in addition to the one invention which applicant previously elected; or

(iii) File a petition under this section traversing the requirement. If the required petition is filed in a timely manner, the original time period for electing and paying the fee set forth in § 1.17(s) will be deferred and any decision on the petition affirming or modifying the requirement will set a new time period to elect the invention or inventions to be searched and examined and to pay the fee set forth in § 1.17(s) for each independent and distinct invention claimed in the application in excess of one which applicant elects.

(3) The additional inventions for which the required fee has not been paid will be withdrawn from consideration under § 1.142(b). An applicant who desires examination of an invention so withdrawn from consideration can file a divisional application under 35 U.S.C. 121.

(c) The provisions of this section shall not be applicable to any application filed after June 8, 1995.

[Added, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995]

## AFFIDAVITS OVERCOMING REJECTIONS

### § 1.130 Affidavit or declaration to disqualify commonly owned patent or published application as prior art.

(a) When any claim of an application or a patent under reexamination is rejected under 35 U.S.C. 103 on a U.S. patent or U.S. patent application publication which is not prior art under 35 U.S.C. 102(b), and the inventions defined by the claims in the application or patent under reexamination and by the claims in the patent or published application are not identical but are not patentably distinct, and the inventions are owned by the same party, the applicant or owner of the patent under reexamination may disqual-